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EXAMINER

DANNEMAN, PAUL

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/688,425	Applicant(s) CATAHAN ET AL.	
	Examiner PAUL DANNEMAN	Art Unit 3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-18, 20-24 and 27-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-18, 20-24, and 27-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This Office Action is in response to Applicant's response filed on 3 December 2009.
2. Claims 1, 10, 13 and 22 have been amended.
3. Claim 29 is newly added.
4. Claim 1-6, 8-18, 20-24, 27-28 and 29 are pending and have been examined in this Office Action.

Response to Arguments

5. The rejection of Claim 10 under 35 U.S.C. § 112 is respectfully withdrawn as applicant has amended Claim 10.
6. The rejection of Claim 10 under 35 U.S.C. § 101 for being directed to non-statutory subject matters is respectfully withdrawn as applicant has amended the claims to recite a system.
7. The objection to Claims 11 and 12 for being dependent on a rejected Claim 10 is respectfully withdrawn as Claim 10 has been amended.
8. Applicant's argument regarding the combining of Knauss and Schwarzhoff ***"would not have been obvious, at least because Knauss depends on predefined mappings and explicitly discloses that any changes require the creation of a new map."*** The argument has been fully considered with regards to Claim 1, 10, 13 and 22 but is rendered moot based on the new grounds of rejection.
9. Applicant's argument regarding the combination of Knauss, Schwarzhoff, and XML (the cited portions) ***"fail to disclose including entity-specific information in a common invoice data object format."*** The argument has been fully considered with regards to Claim 1, 10, 13 and 22 but is rendered moot based on the new grounds of rejection.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple

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assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. **Claims 1-6, 8-18, 20-24, 27 and 28** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-28 of copending Application No. 10/688,094. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are ***directed toward receiving and translating invoice data, to a common data format between two or more applications.***

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

3. **Claims 1-6, 8-18, 20-24, 27-28 and 29** are rejected under 35 U.S.C. 103(a) as being unpatentable over Stark et al, US 7,337,192 B2 hereinafter known as Stark and further in view of

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NPL_XML_Schema_CE and further in view of Schwarzhoff et al., US 6,591,260 B1 hereinafter known as Schwarzhoff.

As per Claims 1-6, 8-18, 20-24 and 27-28, Stark in at least Column 3, lines 34-36 discloses an invention related to data exchange and more particularly, to interfacing disparate data transmission protocols.

Stark in at least Column 4, lines 23-36 further discloses that e-commerce partners who wish to accept a standard XML feed from clients must know what other systems are capable of sending and receiving.

Stark further discloses in at least Column 4, lines 40-49 that the present invention allows the user to map from one file type to another using only the data elements that are key to the transaction involved. Stark

in at least Column 5, lines 27-47 further discloses that the present invention facilitates the ability to reconcile order and invoice information with the financial transaction as well as facilitating the matching of payment information with order, shipment and invoice information. Stark in at least Fig.2 further discloses mapping various dialects of XML between themselves and other file types to facilitate the exchange of data between various applications.

Stark in at least Column 6, lines 9-23 discloses the use of templates containing key data elements that have been mapped (connected) with some number of data elements in the hub. The selected data elements for each file template may be thought of as a reference data element library for that template.

Stark in at least Fig.5, Column 6, lines 50-67 and Column 7, lines 1-5 further discloses mapping key data elements of an invoice into a previously defined set of key data elements (identification data element, a base data element and a shipping data element). Stark does not specifically disclose a pricing and line item details data element per se, however in at least Fig.5 discloses a ListOfInvoiceDetail 86 indicator, therefore it would have been obvious, at the time of the invention, to one of ordinary skill to modify Stark's "Invoice Detail" indicator 86 to include a pricing and line item details data elements with the motivation to insure that the indicator contained the proper invoice information for billing purposes.

Stark in at least Column 7, lines 6-16, Fig.8 and Column 8, lines 38-47 further discloses that the data exchange tool is based on comparing the key data elements within the new input file type with the key data elements for the output file type desired and that the file types can be any file type that the e-

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commerce partner chooses. The data exchange tool defines designated key data elements as the reference data library for the particular file type.

Stark does not specifically disclose the use of complex data elements per se, however in at least Fig.3 discloses loading and displaying an XML file with different element types and in at least Fig.5 discloses in panel 76 a NameAddress which as shown by NPL_Schema_CE on page 3 under the Examples of Complex Elements is a complex element because it contains both elements and text.

NPL_Schema_CE in page 1 and 3-6 discloses the use of Complex Elements and Empty Complex Elements which may be defined as they are needed by a schema. Schwarzhoff in at least Column 5, lines 33-67 further discloses an example of a business Purchase Order document with the use of a schema and redefining or adding an extension to one of the elements on a pre-existing document type. Schwarzhoff in at least Column 6, lines 1-17 further discloses on of the benefits of polymorphism is the expansion of the ,Address> without a rewrite of the Purchase Order.

Therefore, it would have been obvious, at the time of the invention, to one of ordinary skill to combine the well known features of Stark for translating data between a source and target with the well know features of XML Complex Elements with the well known features of Schwarzhoff to include the essential data elements (an identification data element, a base data element, a pricing data element, a shipping data element, and a line item details data elements) of a invoice by using Complex Elements and polymorphism when translating invoice information between applications with the motivation to allow the sharing of data between applications with somewhat similar data in various formats.

As per Claim 29, the Combination of Stark, NPL_XML_Schema_CE and Schwarzhoff does not specifically disclose that the determining of the essential data elements as per Claim 6 facilitates achieving a specified level of compatibility with a data object format (DOF) of a first application per se. However Stark in at least Column 4, lines 45-48, Column 7, lines 55-67 and Column 8, lines 1-2 discloses that data mapped from one file type to another has been pre-programmed or selected by the user to include only the data elements that are key to the transaction involved and to identify and define data elements that are not present in the users data, but are critical to their e-commerce partners. Stark in at

least Fig.5, panel 102 discloses an entry for a "Required Field." Schwarzhoff in at least Column 5, lines 8-17 discloses an example where the purchase orders of individual sellers is likely to have constraints which are unique to the sellers' business which would require a plurality of schemas which are very similar. The plurality of somewhat similar schemas is noted as a deficiency. Therefore, it would have been obvious, at the time of the invention, to one of ordinary skill to modify Stark's data exchange tool to specify a level of compatibility when determining the essential data elements with the motivation to minimize the number of similar data maps, but yet insure that data elements required for the successful transfer of invoice data between application is successfully accomplished.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL DANNEMAN whose telephone number is (571)270-1863. The examiner can normally be reached on Mon.-Thurs. 6AM-5PM Fri. off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Florian Zeender can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Paul Danneman/

Examiner, Art Unit 3627

25 January 2010

/F. Ryan Zeender/

Supervisory Patent Examiner, Art Unit 3627